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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,269	03/09/2006	Jerome Brunel	324-185	6094

22429 7590 11/14/2008

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EXAMINER	
CUMMING, WILLIAM D	
ART UNIT	PAPER NUMBER
2617	
MAIL DATE	DELIVERY MODE
11/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/571,269	BRUNEL ET AL.	
	Examiner	Art Unit	
	WILLIAM D. CUMMING	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6,9 and 11-14* is/are rejected.

7)☒ Claim(s) *3,7,8,10 and 15-18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-6, and 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Kim, et al.**

Kim, et al disclose a system (figure 1) for access to multimedia files through a telecommunication network (#102) from a mobile radiotelephone terminal (#100) for which are intended messages. Each message including an address of the mobile terminal (#100) and a multimedia file transmitted by second terminal ("*One of the techniques of exchanging multimedia information between portable terminals is to automatically connect them to a predetermined server over the Internet wirelessly upon receipt of a periodical message or a particular message and download multimedia information. This technique is implemented by adapting such an application service as for a PC to a portable terminal. Therefore, the portable terminal needs a local memory for storing received multimedia data. A multimedia data file is usually several megabytes in length. To store this multimedia data file, a large capacity local memory is required, which a typical moving-picture terminal cannot afford. In addition, a*

multimedia transmission/reception service is needed aside from the general E-mail service").

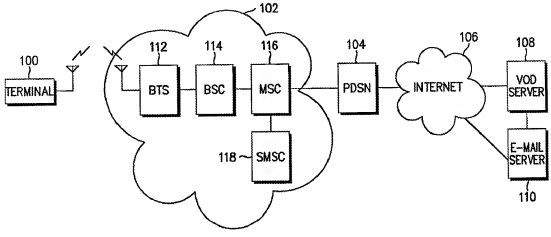

FIG. 1

The system including a server (#108) for detecting a multimedia file in a message transmitted by said second terminal in order to extract therefrom the address of the mobile terminal (#100) and the detected multimedia file, to store the multimedia file extracted from the message in storage space (Abstract)

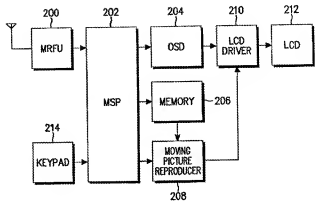

FIG. 2

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Notification means (#110) for transmitting a multimedia file storage notification to the mobile terminal (#100) identified by the address extracted from the message. ("*Meanwhile, a multimedia E-mail according to the present invention is comprised of multimedia data and E-mail data as shown in FIG. 4A. The multimedia E-mail can be made using a bi-directional moving picture terminal with a camera, a PC with a camera, or a multimedia E-mail only generator. An example of a multimedia E-mail window for generating a multimedia E-mail in a PC is shown in FIG. 3. The multimedia E-mail window 300 includes a window 302 for entering the Internet address of the VOD server 108 to receive a multimedia E-mail, a window 304 that displays an image when the image is transmitted, a transmitter information window 306, a receiver information entering window 208, a content window 310, a subject window 312, and icons 314 to 318 with which to select record, reproduce, and transmit.*"

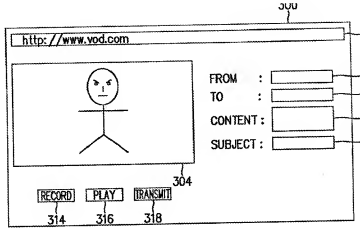
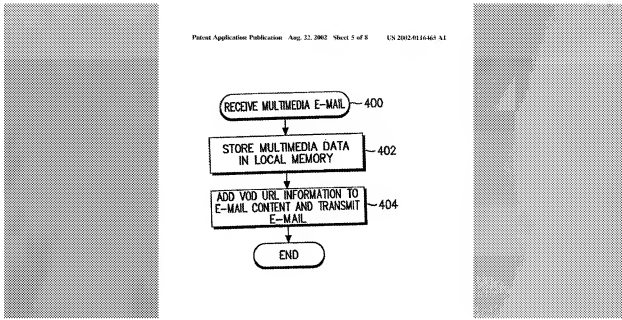


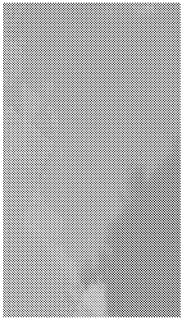
FIG. 3

The storage space being assigned to a user of the mobile terminal (#100) and being accessible to the mobile terminal (#100) through the server (#108) in order for the multimedia file extracted from the message to be stored in the storage means corresponding relationship with the address of the mobile terminal (#100) extracted from the message. ("T*he multimedia E-mail made using a PC or a portable terminal is transmitted to the VOD server 108 via the Internet 106. Then, the VOD server 108 stores only the multimedia data and transmits the E-mail data to the E-mail server 110*.")



The mobile terminal (#100) accessing the stored multimedia file only if the server (#108) has recognized the address of the mobile terminal (#100) supplied after the setting up of a connection between the mobile terminal (#100) and the servers (#108, 110). ("*FIG. 5 illustrates the operation of the VOD server 108. Upon receipt of the multimedia E-mail in step 400, the VOD server 108 stores the multimedia data of a multimedia E-mail in an internal local memory in step 402. In step 404, the VOD server 108 adds VOD URL (Uniform Resource Locator) information as a string of a predetermined format to an E-mail content and transmits the E-mail to the E-mail server 110. As described later, the VOD URL information is added to the E-mail content so that a receiving portable terminal can access data stored in the VOD server 108. Therefore, the URL information has a particular format indicating multimedia data. For example, if URL information is http://wwwvodservice.com/index001/voddata.vod, "http://" and*

"vod" at the end indicate that the URL information is associated with multimedia data. Thus, the E-mail transmitted to the E-mail server 110 has additionally VOD URL information as shown in FIG. 4B."



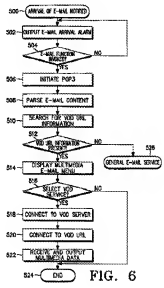
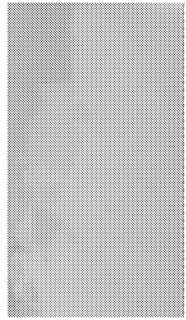


FIG. 6



Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A 35 USC § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC § 101 and should be rejected as being directed to non-statutory subject matter. Thus, to qualify as a 35 USC § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. *Diamondv. Diehr*, 450 U.S. 175, 184 (1981); *Parker* v. *Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. *63*, 70 (1972); *Cochrane* v. *Deener*, 94 U.S. 780,787-88 (1876). In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008).

Allowable Subject Matter

5. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

6. Claims 3, 7, 8, 10, and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed September 18, 2008 have been fully considered but they are not persuasive.

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is *"inherent"* or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Applicant's argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference *"teach"* what the subject patent teaches. Assuming that a reference is properly *"prior art,"* it is only necessary that the claims under consideration *"read on"* something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or *"fully met"* by it. It was held in In re Donohue, 226 USPQ 619, that, *"It is well settled that prior art under 35 USC §102(b)must sufficiently*

describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention." Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be *"given the broadest reasonable interpretation consistent with the specification."* Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "*heavy presumption"* that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). *"Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102."* Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the

invention, the reference then disparages it. The question whether a reference *"teaches away"* from the invention is inapplicable to an anticipation analysis. Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., assigning a customized storage space to the user of the terminal in VOD server, or the storage space SSM is identified by a universal resource locator (URL) address relayed by the server SW, the storage space is only assigned to the user of the mobile terminal T1 because the network knows the address of the mobile terminal, or after setting up the connection between the terminal T1 and the server SW, a request to download a multimedia file FM contained in the storage space is authorized only if the server SW has recognized the address AT1 of the terminal T1supplied by the network RA1 or RP, or a mobile terminal accessing a stored multimedia file only if the server has recognized the address of the mobile terminal supplied after a connection between the mobile terminal and the server has been established, or the server does not add URL information to the email content transmitted to the notification means SN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this action. In the absence of a separate argument with respect to those claims, they now stand or fall with the representative independent claim. *See In re Young,* 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Conclusion

8. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday- Friday, 11:00am-8:00pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WILLIAM D CUMMING/
Primary Examiner
Art Unit 2617

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